

## **REMARKS**

### **1. Status of Claims**

No claims have been canceled, added, or amended, but the claims are nonetheless presented in the foregoing pages for sake of convenience (as is permissible under 37 CFR §1.121).

### **2. Section 3 of the Office Action: Specification (Title)**

Please note that in the prior Response, the title was amended to conform to the suggested title.

### **3. Sections 4-20 of the Office Action: Rejection of Claims 1, 4-7, 10-12, 14-16, 18-20 and 23 under 35 USC §103(a) in view of U.S. Publ'n. 2006/0184504 to Taylor**

Before reviewing the rejections in detail, it is initially useful to review the content and teachings of *Taylor*. *Taylor* is directed to presenting an alternative way to promote one's business on the web apart from use of sponsored banner ads and/or sponsored "preferred placement" (i.e., paying to be listed first in list of search engine results). Pars. [0002]-[0004]. Here, when a user types in a search query for a product or service in an online business directory, the returned search results present a list of relevant products or services found in the directory, plus a "snapshot" of a sponsoring business' web page (so long as that business paid the directory to promote the business in that manner). Par. [0021].

As noted at Par. [0026], the directory could be an online telephone directory, an online email address directory, an online real estate directory, or other forms of online directories. Par. [0028] notes that sponsored listees within the directory may tailor their listings within the directory database(s) as desired, and Par. [0041] states that "the data may include data added by the listee, as well as data such as rebates, coupons, the availability of free calls to the listee, chamber of commerce memberships, recommendations by other users, or other types of data" (and "this data may be displayed with the search results"). Par. [0063] further states that:

this information could include business information such as hours, alternate telephone numbers, types of credit cards accepted, slogans, critics' ratings, or other data. FIG. 11 includes such additional data. For one embodiment, for a listing including individuals, this

information could include personal information such as dating status, hobbies, or religious preference. For one embodiment, for a listing such as a property listing, this information could include property information such as size, number of bedrooms, number of bathrooms, and sales commission rates.

Par. [0073] further notes that a sponsor/listee could have its listing include matter such as “Zip codes, industry, SIC codes, area codes, geographic location, distance from another known location, size of the business, or other criteria”. Par. [0067] further notes that the listee/sponsor can also provide the address/URL of any website to be displayed when the listee/sponsor’s listing is returned to a user from a search query.

A user accesses the directory through a webpage (Par. [0039]), and enters a search query which is passed to a search engine (Par. [0040]). The user’s search query can contain information such as “[business] category, name, location, and/or other features” (Par. [0053]). The search engine then displays the search results to the user (Par. [0042]), with an example of returned search results being shown in FIG. 10. “Framing logic” determines the information to be displayed in the returned search results, which may include a frame of the sponsoring business’ web page (Pars. [0042]-[0043]); FIG. 11 illustrates this feature, wherein CDNow is the sponsor. Other matter, such as an advertisement, may be displayed instead (Par. [0047]). When the sponsoring business’ information is displayed, the sponsoring business pays for such display (Pars. [0044], [0048]-[0052]). As noted at Par. [0074] onward, payment can be calculated in a number of ways, and the “prominence” by which a sponsor/listee is presented in returned search results may be determined in accordance with the amount the sponsor/listee paid in an auction (wherein sponsors/listees bid for the most prominent presentation in a list of returned search results).

Kindly reconsider and withdraw the rejections, since it appears that the teachings of *Taylor* have been misconstrued, and it is not seen how or why one of ordinary skill would truly find the claimed matter obvious in view of *Taylor* and the “Official Notice” matter cited by the Office Action. Regarding claim 1, the Office Action states (starting at page 2) that

Referring to claim 1, Taylor-Yellow-Pages-Superhighway discloses a program storage device readable by a machine and encoding a program of instructions for generating and providing access to electronic mail addresses for individuals in a geographic region (e.g., page 1) . . . .

However, *Taylor* does not generate any electronic mail addresses. It might provide email addresses as part of data returned from a directory search, but only if the email addresses are already present in the directory.

The Office Action further states that *Taylor* discloses:

instructions triggering generation of an electronic mail address for the individual once both the name data and the known location data have been collected wherein: the name data includes at least a family name of the individual, and the location data includes one or more of a country specific postal address locator code [and] a region specific portion of a telephone number (e.g., page 2);

This matter is simply not seen in *Taylor*. There is no disclosure whatsoever of generation of an electronic mail address, much less one which is generated upon collection of an individual's family name and a postal address locator code or a region specific portion of a telephone number.

The Office Action further states that *Taylor* discloses:

the instructions including: instructions generating [a personal] name code indicative of the collected name data of the individual (e.g., page 2);  
instructions generating a location code indicative of the collected known location data of the individual (e.g., page 2);  
and instructions generating the electronic mail address for the individual based on the personal name code and the location code (e.g., page 2);

Here too, there is no disclosure whatsoever in *Taylor* of generation of a personal name code, a location code, or an electronic mail address for the individual based on the personal name code and the location code.

The Office Action further states that *Taylor* discloses:

instructions [] submitting the electronic mail address for the individual to the database; and  
instructions searching the database using the personal name code and the location code for the individual to locate the electronic mail address of the individual (e.g., page 2).

Here too, there is no disclosure whatsoever of *Taylor* adding a generated electronic mail address to the database, and allowing searching for the electronic mail address by use of a personal name code and location code. *Taylor* only uses preexisting email addresses in a directory (if it uses email addresses at all), and it does not generate new email addresses and allow for their searching.

*Taylor* therefore does not disclose, or even suggest, the matter that it is alleged to disclose. If the Office nevertheless believes *Taylor* to disclose or suggest the aforementioned features, it is respectfully requested that the Office identify *with particularity* the location and content of the alleged disclosure or suggestion so that the Applicant may better respond. See 37 CFR §1.104(c)(2): “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. *When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.*” (Emphasis added.) Also see, e.g., *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference”, citing to *In re Yates*, 211 USPQ 1149, 1151 (CCPA 1981)). The generalized citations given by the Office Action – e.g., to “page 1” of *Taylor* – are too broad to identify where the alleged teachings are present, particularly where the Office could readily cite to the paragraph numbers given by *Taylor* instead. As noted in the prior Response, the USPTO’s new *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, at 72 Federal Register 57526 (currently available at <http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf>) require that any obviousness rejection *must* clearly identify the differences between the claimed invention and the prior art. Here, there is no such clear identification.

In similar respects, a review of the “Official Notice” references reveals that most (if not all) of these do not in fact disclose use of standardized email addresses, as they are alleged to do. Rather, it seems that these references either (1) simply already have a database which includes email addresses, and they generate an email to a recipient at an email address upon occurrence of some event, or (2) generate an email address from a telephone number or the like. 37 CFR §1.104(c)(2) requires that “[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the *best references* at his or her command” (emphasis added), and MPEP 904.03 similarly states that “[t]he examiner is not called upon to cite all references that may be available, but only the ‘best.’ .

... The best reference should always be the one used.” In view of these principles, kindly simply cite the *one reference*, or at most a *few references*, which are believed to best illustrate that “the concept and advantages of providing standardized email addresses is well known and expected in the art.” The current list of “Official Notice” references appears to contain many irrelevant references or citations and is burdensome to review, and reducing the number of citations to the few that are the truly “best references” will assist in simplifying issues for further examination. It is also notable that these same references (and passages) were cited in the Office Action of October 19, 2007 as allegedly illustrating *different matter* – namely, generating an email upon the occurrence of a trigger event. See, e.g., page 9 of that Office Action. Is it now alleged that these *same* references all *also* illustrate “the concept and advantages of providing standardized email addresses”? Again, a review illustrates that this is not the case. Have the correct references been cited in support of the “Official Notice,” or has an error been made?

The Office Action further alleges that:

Taylor-Yellow-Pages-Superhighway does not specifically mention about standardized email addresses. “Official Notice” is taken that both the concept and advantages of providing standardized email addresses is well known and expected in the art. . . . It would have been obvious to one of ordinary skill in the art at the time the invention was made to include standardized email address with the teachings of Taylor-Yellow-Pages-Superhighway in order to facilitate usage of the standardized email addresses because the email address would provide information regarding the owner of the email address. The standardized email address would enhance differentiating email addresses with the owner specific information.

This is incorrect. Initially, the use of email addresses is relatively irrelevant to *Taylor*, which is simply directed to presenting attention-getting directory search results by allowing one to display a snapshot of their website, or an advertisement or the like, when their listing is presented in the results of a directory search. It is not seen why “usage of the standardized email addresses” would truly enhance this system in any respect, regardless of any alleged use of standardized email addresses in the “Official Notice” references. Moreover, given that *Taylor* lacks the features noted above, it is not seen how or why one of ordinary skill *could* attain the claimed invention from *Taylor*, much less how or why one *would* do so. Information regarding the owner of the email address is already provided in detail in *Taylor*’s search results: a snapshot of the owner’s website is provided, and the

owner's own owner-selected email address may also be provided. Why then would one truly find it useful to have the *Taylor* system automatically generate a new/additional email address, particularly where it is not even an address which the owner has selected and assigned to itself? Kindly withdraw the rejection of claim 1. These comments are also relevant to the rejections of the other independent claims 7 and 23.

Similar arguments apply for the remaining claims. Regarding claim 4, the Office Action alleges:

Taylor-Yellow-Pages-Superhighway also discloses wherein one or more email addresses are automatically created for each individual in a country, geographic, region or state without each individual providing name and known location data to the program storage device (e.g., page 3).

However, *Taylor* is not in fact seen to disclose this matter, either at page 3 or elsewhere. The *Taylor* system does not generate email addresses, and simply uses whatever email addresses are present in the directory. These comments are also relevant to the rejection of claim 10.

Regarding claim 5, the Office Action alleges:

Taylor-Yellow-Pages-Superhighway also discloses wherein one or more subsidiary addresses, including existing electronic addresses, are associated with the electronic mail address of the individual in the database (e.g., page 3).

*Taylor* is also not seen to disclose this matter, either at page 3 or elsewhere. There is no mention or suggestion whatsoever of subsidiary addresses. These comments are also relevant to the rejection of claim 11.

Regarding claim 6, the Office Action alleges:

Taylor-Yellow-Pages-Superhighway also discloses wherein the instructions are further operable to attach a unique numeric identifier to the electronic mail address of the individual (e.g., page 4).

*Taylor* is also not seen to disclose this matter at page 4 or elsewhere. There is no mention or suggestion whatsoever of numeric identifiers. These comments are also relevant to the rejection of claims 12, 16, and 20.

**4. Sections 4-20 of the Office Action: Rejection of Claims 1, 4-7, 10-12, 14-16, 18-20 and 23 under 35 USC §103(a) in view of U.S. Patent 6,230,188 to Marcus**

US 6,230,188 to *Marcus* provides a system for allowing emailing to an individual in an online directory without exposing the individual's email address. When a user searches a directory for a particular person and that person's email address is present in the directory, the system returns a listing for the sought person along with a proxy email address for the person (rather than their real email address from the directory), wherein email sent to the proxy email address is directed to the person. Column 2 lines 26-54; see also Abstract. This allows the person's "true" email address within the directory to remain confidential. The directory is compiled from telephone directory listings (column 3 lines 16-27), and searching for a person's email address in the directory is described in greater detail at column 3 lines 46-57, wherein a user may search for a person using information such as name or address. Generation of the proxy email address once a person is found in the directory is described in greater detail at column 3 line 58-column 4 line 18, and the proxy email can include a first portion with a selectable word (such as "send") followed by a second portion containing the domain of the person's true email address (column 3 line 63-column 4 line 18). Once a person is selected from the directory search results, the system presents an email entry screen wherein the user may enter an email to be sent to the selected person (with only the proxy email address being shown), and the email is then sent to the selected person without displaying their "true" email address. Column 4 line 18 onward. As noted at column 5 line 16 onward, this system helps prevent spam emails by keeping a user's true email address private.

Here too the matter allegedly disclosed by *Marcus* is largely not in fact present in *Marcus*, and the overbroad citations to *Marcus* – e.g., to "col. 2" rather than to specific line numbers within a column – are of little help. To illustrate, the Office Action alleges that *Marcus* discloses:

instructions creating an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being created once the name data and the known location data of the individual are collected (e.g., col., 2);

However, it is not seen where this is in fact disclosed at column 2 of *Marcus*. *Marcus* could be regarded as generating a proxy email address for an individual once the individual's email address is found in the directory, but there is no "at least partial" entry created once name and known

location data are collected.

The Office Action also alleges that *Marcus* discloses:

instructions triggering generation of an electronic mail address for the individual once both the name data and the known location data have been collected wherein: the name data includes at least a family name of the individual, and the location data includes one or more of a country specific postal address locator code a region specific portion of a telephone number (e.g., col., 2);

Again, *Marcus* generates a proxy email address for an individual once the individual's email address is found in the directory. Family name, country specific postal address locator code, and/or region specific portion of a telephone number are irrelevant.

The Office Action also alleges that *Marcus* discloses:

the instructions including: instructions generating name code indicative of the collected name data of the individual (e.g., col., 2); instructions generating a location code indicative of the collected known location data of the individual (e.g., col., 2); and instructions generating the electronic mail address for the individual based on the personal name code and the location code (e.g., col., 2);

However, *Marcus* does not generate a proxy email in this manner. *Marcus* instead uses:

a first portion and a second portion. The first portion is provided in lieu of the listing's alias, or user name, and is given as a selectable word, such as "Send", with underlining to indicate to the user that the text is a selectable link. The second portion is given as the listing's domain name.

(Column 3 line 63-column 4 line 2; see more generally column 3 line 58-column 4 line 18.) There is no disclosure or suggestion whatsoever of using personal name code and location code when generating a proxy email.

The Office Action also alleges that *Marcus* discloses:

instructions to submitting the electronic mail address for the individual to the database; and instructions searching the database using the personal name code and the location code for the individual to locate the electronic mail address of the individual (e.g., col., 2).

However, *Marcus* does *not* save the proxy email address in the directory (or any other database). It does not need to do so; it is merely generated on-the-fly as a proxy for the real email address stored in the directory. Since it is not itself a real email address, there is no benefit to storing it; outside of its use in the *Marcus* system as a "mask" for the true (and stored) email address, it has no use whatsoever (since outside of the *Marcus* system, it is not a valid email address). *Marcus* also does not allow searching of the proxy email address by use of its elements (the elements present in



the proxy email address), and it would be nonsensical to do so – it contains no information about the individual since it is merely a “selectable word” plus a domain (e.g., send@domain.com). Users who wish to search for an individual cannot reasonably be expected to locate a desired individual, and/or the individual’s email address, by use of these elements.

The Office Action alleges that claim 1 is obvious in view of a rationale similar to that applied for the *Taylor* reference discussed above:

Marcus- Infosys-Inc does not specifically mention about standardized email addresses. . . . It would have been obvious to one of ordinary skill in the art at the time the invention was made to include standardized email address with the teachings of Marcus-Infosys-Inc in order to facilitate usage of the standardized email addresses because the email address would provide information regarding the owner of the email address. The standardized email address would enhance differentiating email addresses with the owner specific information.

The rejection should be withdrawn for reasons similar to those discussed with respect to the *Taylor* reference. *Marcus*, even if modified to incorporate the alleged “Official Notice” matter, would not amount to the invention *as claimed*, and additionally there does not appear to be any true reason why one would modify *Marcus* to attain the claimed invention. This is particularly true when one considers that the entire purpose of *Marcus* is to hide an individual’s email address from others unless and until that individual wishes to reveal it to an email sender: given this purpose, *why would an artisan wish to defeat this purpose by generating a standardized and searchable email address, one whose contents/elements are presented in such a manner that they can be easily deduced even if one does not know the individual’s email address, and which may be readily searched by its elements?* See MPEP 2143.01 (subsection entitled “The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose”). Kindly withdraw the rejection of claim 1, and likewise of independent claims 7 and 23 (and of all claims dependent on these claims).

All dependent claims are similarly submitted to be allowable. Regarding claim 6, the Office Action alleges:

Referring to claim 6, Marcus-Infosys-Inc discloses the claimed limitations as rejected above. Marcus-Infosys-Inc also discloses wherein the instructions are further operable to attach a unique numeric identifier to the electronic mail address of the individual (e.g., col., 4).

*Marcus* is not in fact seen to disclose this matter at column 4 or elsewhere. There is no mention or suggestion whatsoever of numeric identifiers. These comments are also relevant to the rejection of claims 12, 16, and 20.

**5. Sections 4-20 of the Office Action: Rejection of Claims 1, 4-7, 10-12, 14-16, 18-20 and 23 under 35 USC §103(a) in view of U.S. Patent 6,108,691 to Lee et al.**

US 6,108,691 to *Lee et al.*, like US 6,230,188 to *Marcus*, is also directed to a directory service allowing a user to receive emails from directory users without requiring the recipient to reveal his/her email address. (See Abstract.) Conventional online telephone directories and the like are given as examples of directories that might be used in the invention (column 1 lines 17-23, column 2 lines 33-51). Searches of directory records may be done by entering, for example, “the name of an individual or business, and a desired city and state” (column 3 lines 13-31). Records containing, for example, “a particular address or phone number” are returned (column 3 lines 32-49). Users/searchers who register for the directory service (column 4 line 62 onward) may specify a password and provide information such as their email address (column 5 lines 1-11). The user may then specify whether his/her email address is to be revealed or to remain private when the user sends emails to directory listees (column 6 line 23 onward). The user may also specify whether the user is to be included in the directory, and which information (e.g., email address) is to be included in the directory (column 6 line 55 onward; see also column 8 lines 22-58).

When a user wishes to send an email to a directory listee, the system first allows generation of an email to the directory listee wherein the user requests the directory listee’s email address (with this email not making the directory listee’s email address visible/available to the user). Column 7 lines 33-59. The recipient / directory listee may then choose whether to respond to the user and make his/her email address known to the user (column 7 line 60-column 8 line 5).

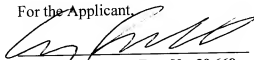
It is therefore seen that *Lee et al.* is substantially similar to *Marcus*, save that *Lee et al.* does not even generate a proxy email address: *Lee et al.* simply hides an individual’s email address unless and until the individual chooses to reveal it. These rejections should therefore be withdrawn for the same reasons as set forth above with respect to *Marcus*: *Lee et al.*, even if modified to incorporate

the alleged “Official Notice” matter, would not amount to the invention *as claimed*, and additionally there does not appear to be any true reason why one would modify *Lee et al.* to attain the claimed invention. Again, since *Lee et al.*’s function is to hide an individual’s email address from others until that individual wishes to reveal it, it is contrary to *Lee et al.*’s intended purpose to generate another email address for the individual – one which uses name and location data, and which would readily be deduced by a searcher (particularly since the name and location data would be provided by the directory) – since this thwarts *Lee et al.*’s intended purpose of hiding the individual’s email address until he/she chooses to reveal it. Kindly withdraw the rejections.

**6. In Closing**

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



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